

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Anna Maria Zara et al

Confirmation No.: 7529

Application No.: 09/666,910

Examiner: Igor N. Borissov

Filing Date: Sept. 21, 2000

Group Art Unit: 3625

Title: Intelligently Classifying And Handling User
Requests In A Data System

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

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DEC 11 2003
GROUP 3600

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment () Petition to extend time to respond
() New fee as calculated below () Supplemental Declaration
(X) No additional fee (Address envelope to "Mail Stop Non-Fee Amendment")
() Other: (fee \$)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$18	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$86	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$290	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$420.00	3RD MONTH \$950.00	4TH MONTH \$1480.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

Date: Dec 9, 2003

I hereby certify that this document is being filed by personal delivery to the Customer Service Window, Crystal Plaza 2, 2011 South Clark Place, Arlington Virginia, of the United States Patent & Trademark Office on the date indicated above.

By: Patrick C. Keane No 32858
(Attorney Signature and Reg. No.)

Respectfully submitted,

Anna Maria Zara et al

By: Patrick C. Keane

Patrick C. Keane

Attorney/Agent for Applicant(s)
Reg. No. 32,858

Date: Dec. 9, 2003

Telephone No.: (703) 838-6525



12-18-03
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Walden
Patent

Attorney's Docket No. 10002185-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
)	
Anna Maria Zara et al)	Group Art Unit: 3629
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Application No.: 09/666,910)	Examiner: Igor N. Borissov
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Filed: Sept. 21, 2000)	Confirmation No.: 7529
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For: INTELLIGENTLY CLASSIFYING)	
AND HANDING USER REQUESTS)	
IN A DATA SYSTEM)	
)	
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AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed September 9, 2003, reconsideration and allowance of the present application are respectfully requested. Claims 1-19 remain pending in the application.

On page 2 of the Office Action, claims 16 and 18 are rejected under 335 U.S.C. §112, first paragraph, as containing subject matter which the Examiner asserts to be "new matter". Specifically, the Examiner asserts that the "server engine" of claim 16 and the "cache" of claim 18 constitute new matter. These rejections are respectfully traversed. The "server engine" of claim 16 is, for example, described as part of the server of the Figure 2 server module 33 as described, for example, at specification page 11, line 19

through specification page 12, line 18. The "cache" of claim 18 was described in accordance with Applicants' exemplary Figure 2 embodiment, as part of the "application engine" 38 of the application system 35, as described, for example, at specification page 16, line 25 through specification page 17, line 1. Because the features objected to by the Examiner are clearly described in the originally filed application, withdrawal of the rejection of claims 16 and 18 under 35 U.S.C. §112, first paragraph, is respectfully requested.

Later, on page 2 of the Office Action, claim 16 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite. More particularly, claim 16 is objected to as describing method steps, and is asserted to be confusing because "it is not clear what method steps does the term 'determine' contemplate". These objections to claim 16 are traversed. Claim 16 is directed to a data service system which contains, among other features, a server engine and a content generator. The functional statements set forth in claim 16 are supported by the structural elements provided therein, and as such, constitute proper elements of an apparatus claim. The Examiner's objection to the term "determines" in claim 16, is confusing. Claim 16 clearly recites that the "server engine" performs a function of determining if requests are to be directed to content generator or the application system. Because claim 16 is clear, and in compliance with 35 U.S.C. §112, withdrawal of this rejection is respectfully requested.

On page 3 of the Office Action, claims 1-19 are rejected as being unpatentable over U.S. Patent No. 6,055,564 (Phaal) in view of U.S. Patent No. 6,341,369 (Degenaro et al). This rejection is respectfully traversed.

In responding to Applicants' previous remarks regarding this rejection, the Examiner asserts on page 6 of the Office Action that the Phaal patent can be used as prior art because a Patent Office record from the Assignment Branch (a copy of which was attached to the Office Action), identifies the execution date of the assignment recorded in the U.S. Patent Office as November 6, 2000; November 27, 2000; and December 9, 2000, for each of the three inventors respectively. However, the execution date of the assignment and/or the recordation date of the assignment do not, in the present case, determine the applicability of 35 U.S.C. §103(c). As correctly noted by the Examiner, 35 U.S.C. §103(c) states that subject matter shall not preclude patentability under 35 U.S.C. §103:

... where the subject matter and the claimed invention were,
at the time the invention was made, owned by the same
person or **subject to an obligation of assignment** to the same
person (emphasis added).

The assignment document referenced by the Examiner does not constitute the inventors obligation to assign, but merely formalizes the assignees ownership of the invention and provides a separate document that can be easily recorded in the U.S. Patent Office. The "obligation of assignment" as referred to in 35 U.S.C. §103(c) stems from the employment of the inventors by the assignee. The rights of Hewlett-Packard company to

the claimed invention, existed at the time the present application was filed, as was attested to in the remarks accompanying Applicants' previous response. The statements set forth in Applicants' previous response are sufficient for refuting a rejection based on 35 U.S.C.

§103. For example, M.P.E.P. §706.02(1)(2) specifically states on M.P.E.P. page 700-54:

... the attorney or agent of record for Application X states, in a clear and conspicuous matter, that:

'Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z'.

- This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. §103(a) against the claims of Application X

In Applicants' previous July 1, 2003 response, on page 9, Applicants' representatives specifically stated that 35 U.S.C. §103(c) shall not preclude patentability:

... where the subject matter and the claimed invention were at **the time the invention was made**, owned by the same person or **subject to an obligation of assignment** to the same person ... In the present case, the Examiner cites Phaal (6,055,564) although both Phaal and the claimed invention have been subject to an obligation of assignment to Hewlett-Packard Company.

Applicants' representative clearly correlated the obligation of assignment to Hewlett-Packard Company. In addition, the application cover sheet as filed with the application indicates that the application was prepared by Hewlett-Packard Company. As such, the Phaal patent is inappropriate as a reference under 35 U.S.C. §103 in the present application. Should the Examiner have additional questions regarding common ownership

of the present invention and the Phaal patent, it is respectfully requested that the undersigned be contacted.

Even assuming the Phaal patent were an appropriate reference in the present application, the Phaal patent considered either individually or in combination with the Degenaro patent in the manner relied upon by the Examiner, would not have resulted in the presently claimed invention as recited in independent claims 1, 9 and 14.

Independent claim 1 is directed to a data service system such as the exemplary data service system of Applicants' Figure 2. The data service system of claim 1 specifically includes a server system, such as the Figure 2 server system 31, and an application system, such as the Figure 2 application system 35. Then claim 1 server system includes a request processor, such as request processor 32 of Figure 2. The application system is coupled to the server system, and further includes an application engine (such as application engine 38), a business rule engine (such as business rule engine 37) and a tag generator (such as tag generator 36). As recited in claim 1, the business rule engine stores business rules regarding classification of various transactions, and uses the business rules to analyze some of the transaction responses. The tag generator generates a classification tag for a particular transaction in a session based on the analysis of its associated transaction response by the business rule engine.

The Examiner acknowledges on page 4 of the Office Action that:

Phaal does not specifically teach storing business rules regarding classification of various transactions, and using the business rules to obtain the classification information of the transactions.

The Examiner relies upon the Degenaro patent as teaching a method and apparatus for specifying and applying the rules to classification-based decision points in an application system, and refers to portions of the Degenaro patent as set forth in the Abstract and at column 3, lines 58-63. The Examiner concludes in the third paragraph on page 4 of the Office Action that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Phaal to include use of set of business rules regarding classification of various transactions to obtain the classification information of the transaction, because it would make the system more versatile, thereby making it more attractive for the customers.

On page 6 of the Office Action, in the last two paragraphs, the Examiner responds to Applicants' previous arguments. Here, the Examiner again refers to the Abstract, and to column 3, lines 58-63 of the Degenaro patent, as disclosing a set of business rules regarding classification of various transactions to obtain the classification information of the transaction. In the paragraph bridging pages 6-7 of the Office Action, the Examiner additionally refers to column 5, lines 14 through column 7, line 57 of the Degenaro patent as disclosing the use of a set of business rules regarding classification of various transactions to obtain the classification information of the transaction. The Examiner refers to various case cites on page 7 of the Office Action, which have been discussed in Applicants' previous responses, the comments of which are incorporated herein by reference. However, the Examiner's comments fail to establish a *prima facie* case of obviousness in rejecting independent claims 1, 9 and 14 over the Phaal and Degenaro

patents, because the Degenaro patent fails to provide the teaching or suggestion for which it is relied upon in addressing the shortcomings of the Phaal patent as identified by the Examiner.

Exemplary embodiments of the present invention employ a rule engine to analyze responses to transaction requests. A tag generator is used for generating a classification tag for a particular transaction in a session, based on the analysis of an associated transaction response by the business rule engine. The classification tag is attached to the transaction response before it is returned to the requesting external client, to be subsequently attached by that client to any succeeding request in that session (see claim 1). Requests to be serviced by the server system are scheduled, at least in part, based on classification information contained in the tag of each subsequent external request (see claim 9). Thus, exemplary embodiments generate a classification tag based on the analysis of a transaction response by a business rule engine that stores business rules regarding classification of various transactions.

The Degenaro patent, in contrast, is not used for determining the scheduling of transaction requests from external clients. Rather, the Degenaro patent is merely directed to specifying a set of control point names for each of plural control points in an application, so that the state of an application at each control point can be analyzed. The rules referred to in the Degenaro patent are associated with this classification so that the behavior of the application can be affected at the specified control points.

According to the operation described in the Degenaro patent, when a control point in a particular application being executed is encountered, the classification category associated with each control point is used to select a set of classification rules that are to be run at that classification point. As described at column 3, lines 58-63, the control points are built into the application at those points in the application flow at which variable behavior controlled by rules is desired. The Degenaro patent is not, however, directed to the use of business rules to generate a classification tagging that can be attached to a transaction response before it is returned to a requesting external client. Such a classification tag is not described as being subsequently attached to succeeding requests in a given session. As such, the Degenaro patent, considered individually or in combination with the Phaal patent, fails to teach or suggest Applicants' claim 1 combination, and claim 1 is allowable.

Similarly, independent claims 9 and 14 are allowable. Claim 9 recites, among other features, generating a tag containing classification information obtained using business rules, and scheduling requests to be serviced by the server system based at least in part on the classification information contained in the tag of each subsequent external request. Claim 14 recites, among other features, a business rule engine, and a tag generator configured for generating, and regenerating, transaction classifications that correspondingly attach to responses before they are returned to the clients, each transaction classification being associated with a particular session and being used with any subsequent requests

within that session. As such, independent claims 9 and 14, like claim 1, are allowable over the Phaal and Degenaro patents.

All of the remaining claims depend from the aforementioned independent claims and recite additional advantageous features which further distinguish over the patents relied upon by the Examiner. As such, all claims are considered allowable.

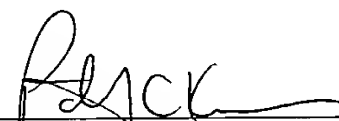
All objections and rejections raised in the Office Action having been addressed, the present application is in condition for allowance and a Notice of Allowance is respectfully solicited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 9, 2003

By: _____


Patrick C. Keane

Registration No. 32,858

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620